

## **REMARKS**

**Claims in the Application.** Claims 7, 13-16, 20, 21, 25-36, 39, 45 and 46 have been cancelled from this application. Claim 48 has been added. Accordingly, claims 1-6, 8-12, 17-19, 22-24, 37, 38, 40-44, 47, and 48 are active in this application. Reconsideration is respectfully requested.

**Examiner's Rejections Under 35 U.S.C. § 112, ¶ 2.** The Examiner has rejected claims 1-6, 8-12, 17-19, 22-24, 37, 38, 40-44 and 47 under 35 U.S.C. 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner's suggested amendments to the claims have been made in the claims as listed herein, thus overcoming this objection. Applicant wishes to thank the Examiner for his generous suggestions.

Regarding amendments to claims 1 and newly added claim 48, the feature "applying a lamination lamination exclusively to the separating surfaces..." is disclosed in [0029] and [0030].

**Examiner's Rejection Over Noergaard.** The Examiner has rejected claims 1, 3-6, 8-12, 19, 22-24, 37, 38, 40-44, and 47 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,981,024 ("Noergaard"). This ground for rejection is traversed.

The Examiner states that "according to the office action, it shall be clear from Noergaard that insulating products may be provided with laminations on either or both sides of the insulating material (column 19, lines 15 to 21). Thus, one of ordinary skill in the art reading Noergaard would have been motivated to apply foil materials which satisfy the claimed lamination to either or both sides of the insulating materials shown in Figure 7 according to the desired properties of the final product." Applicant respectfully disagrees. The cited section in column 19 relates to the preparation of a composite mineral fiber web **before** the composite mineral fiber web is being processed in a curing oven.

Thus, Noergaard suggests the following subsequent process steps:

1. applying a top and bottom layer to a folded and compacted mineral fiber web;
2. curing the folded and compacted mineral fiber web with applied top and bottom layers in a curing oven;

3. causing separation of the **cured** mineral fiber web by means of a wire or belt separator.

In contrast, the method according to the invention comprises the following subsequent steps:

1. curing a mineral fiber web in a curing oven;
2. separating the cured mineral fiber web by means of a cutting mechanism; and
3. applying a lamination to at least one of the separating surfaces, resulting from the separation of the **cured** mineral fiber web.

Applying a lamination to a separating surface is not anticipated or motivated by Noergaard. Noergaard suggests a plurality of different laminations and processing steps, but the application of a lamination to a separating surface is **not** suggested. This is because the separating surface of a **cut** mineral fiber web has considerably different characteristics than the surface of an **uncut** mineral fiber web. They differ in terms of roughness, characteristics of bonding with adhesives and the like, fiber orientation and many more. Therefore, the teaching of Noergaard concerning the application of a lamination to the large surfaces of a non-separated mineral fiber web cannot be transferred to a separating surface of a separated, cured mineral fiber web in an obvious manner.

The Examiner argues that teachings in Noergaard would have motivated the person of ordinary skill in the art to apply foils to either or both sides of an insulating web. In this context, the Examiner disregards the argument given by the applicant, that the teaching of Noergaard in terms of the foils being restrained to those surfaces of a mineral fiber web, that have not been cut at all. Therefore, the application of lamination to at least one of the separating surfaces is not obvious in view of Noergaard.

Further, the Examiner argues that the application of foils to both surfaces of the insulating material **after** curing the insulating material in a curing oven would be well known in the art. Applicant disagrees. The teaching of Noergaard as well as the state of the art in general is to apply a foil to a mineral fiber web and subsequently to cure the resulting composite mineral fiber web in a curing oven. In contrast, the state of the art gives no hint to apply a foil to the separating surface **after** curing a composite mineral

fiber web in a curing oven. Particularly, the application of a foil to a separating surface without curing the composite mineral fiber web afterwards is not known at all. At best, a person of skill in the art would only have been motivated to apply the process step of curing a composite mineral fiber web in a curing oven after a foil has been applied to a separating, that means untreated surface of the mineral fiber web.

The Examiner is therefore respectfully requested to reconsider the rejection of the claims over Noergaard.

**Examiner's Rejection Over Noergaard and Klose.** The Examiner has rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Noergaard in view of U.S. Patent No. 4,917,750 ("Klose"). This ground for rejection is traversed. Klose does not cure the deficiencies of Noergaard as discussed in the paragraphs above. The combination of Noergaard and Klose, therefore, does not render claim 2 unpatentable.

**Examiner's Rejection Over Noergaard and Metcalfe.** The Examiner has rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Noergaard in view of U.S. Patent No. 4,128,678 ("Metcalfe"). This ground for rejection is traversed. Like Klose, Metcalfe does not cure the deficiencies of Noergaard. The combination of Noergaard and Metcalfe therefore does not render either claim 17 or 18 unpatentable.

**Conclusions.** The Examiner is respectfully requested to issue a Notice of Allowance in light of the above remarks. He is further respectfully requested to telephone the undersigned should he deem it prudent to more expeditiously advance the prosecution of this application.

Respectfully submitted,

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